



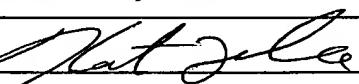
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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b> as Express Mail No. <b>EV544475539US</b>		Docket Number (Optional) <b>P6263</b>
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as <u>first class mail</u> in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p><b>November 18, 2005</b></p> <p>on _____</p> <p>Signature </p> <p>Typed or printed name <b>Kent A. Lembke</b></p>		<p>Application Number <b>09/932,553</b></p> <p>Filed <b>August 17, 2001</b></p> <p>First Named Inventor <b>James E. Hebert</b></p> <p>Art Unit <b>2663</b></p> <p>Examiner <b>JUNTIMA, Nittaya</b></p>

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record. **44,866**  
Registration number \_\_\_\_\_

attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

**Kent A. Lembke**

Typed or printed name

**720-406-5378**

Telephone number

**November 18, 2005**

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. 09/932,553	Confirmation No.: 3908
Application of: James E. Hebert	Customer No.: <b>32658</b>
Filed: August 17, 2001	
Art Unit: 2663	
Examiner: JUNTIMA, Nittaya	
Attorney Docket No. P6263 (formerly 5160-08)	
For: REDUNDANT COMMUNICATION ADAPTER SYSTEM FOR CONNECTING A CLIENT TO AN FDDI NETWORK	

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action mailed August 24, 2005 and the Advisory Action mailed October 19, 2005, Applicant requests that the claim rejections be reviewed prior to the filing of an Appeal Brief for the reasons provided in the following paragraphs.

Issues for Review

Applicant believes there are clear errors in the Examiner's rejections that should be reviewed and that such a review will show that the cited references do not support a *prima facie* obviousness rejection. The issues for review do not involve determining what a reference teaches but instead involve determining whether what is taught by the reference as construed by the Examiner supports a *prima facie* rejection of claims based on obviousness.

A significant issue for review is whether Applicant's argument relies upon features not in the claims as indicated in the Advisory Action. Specifically, the Advisory Action indicates that "generating a connectivity signal destined to the

primary switch", "detecting a response signal generated by the primary switch", and "wherein the connectivity signal includes an electrical NIC connectivity test signal" are features not in the rejected claims. However, the sixth element of claim 1 calls for "program signals stored in the memory of the server and defining an executable program for:" "generating a connectivity signal to the primary switch..." and "monitoring the primary I/O port to detect a response signal from the primary switch...". Hence, the first two features said to be missing from the claims are at least in claim 1, and the Examiner's rejection of the claims for the reason that the arguments were not based on pending claim language is incorrect and should be overturned.

The third feature said to be argued is actually taken out of context by the Examiner. Applicant argued on page 10 first paragraph of the September 15, 2005 Amendment that "claim 1 only calls for a connectivity signal to be used which may include lower level testing such as electrically NIC connectivity tests." Applicant was distinguishing a reference based on the claim language calling for use of "a connectivity signal" with an added explanation of one construction of that claim language. Hence, the Examiner's disregard for the distinguishing arguments should be overturn for this additional reason.

The first two features the Examiner indicated were missing from the claims are two of the important features of the claimed inventions. Claims 1-6, 8-13, and 15 stand rejected under 35 U.S.C. §103(a) as being obvious over the Background of Applicant's specification in view of U.S. Pat. No. 6,392,990 ("Tosey"). A reviewable issue is whether the Examiner gave proper weight to the claim language requiring generating a connectivity signal to the primary switch and detecting when a response signal from the primary switch is not received. Another reviewable issue is whether the Examiner has failed to state a *prima facie* case of obviousness because Tosey simply does not support a rejection of these claims even when it is construed as argued by the Examiner.

Claim 1 is directed to a communication adapter system that includes in a server a primary I/O board and a secondary I/O board as well as a primary switch and a secondary switch that link the adapter system to a network. An executable program is provided on the server that generates a connectivity signal to the primary switch to test connectivity from the primary I/O board to the primary switch. When a response signal is not received from the primary switch in a predetermined time period, a primary NIC is configured to disable data transfer to the primary switch and a secondary NIC is configured to enable data transfer through the secondary switch. Emphasis is added to indicate key differences between Tosey and the claimed invention, i.e., Tosey is directed toward peer-to-peer connectivity testing and fails to teach performing a connectivity test between a primary NIC to a primary switch. Because Tosey teaches a method that tests a different connectivity, it fails to teach each and every element of claim 1 even when combined with Applicant's Background teaching.

In the Response to Arguments of the Final Office Action, the Examiner states on page 10 that "Tosey teaches generating a connectivity signal (a ping) to the primary switch (hub A 22) to test connectivity from the network computing device 21 to the primary switch," and the Examiner believes this follows since the device 21 is passing the ping through the hub on its way to the peer device. However, claim 1 specifically calls for sending a connectivity signal to the switch and to receive a response from the switch. This is functionally very different than the Tosey teaching of passing a ping through a hub to a peer device and then passing a response from the peer device through the hub to the sending network device. With the claimed system, the lack of a response indicates there is no connectivity between the switch and the primary NIC, which can be addressed as claimed by connecting the secondary NIC to the secondary switch.

In contrast, in Tosey, a lack of a response may indicate a connectivity problem anywhere between the peer device and the sending device – but would not definitively indicate the problem was between the sending device and the hub as the hub did not generate and send a response (i.e., is not responsible for

responding). Hence, the fix provided in claim 1 may not be useful in Tosey as setting up a path to a new hub may not fix the connectivity issue (such as when the problem is between the hub and the peer). Tosey fails to show at least the generating of a connectivity signal that is sent to the primary switch and monitoring for a response signal from the primary switch (i.e., Tosey teaches sending a signal through the hub and receiving a signal from a peer through the hub), and claim 1 is not made obvious in light of the Tosey teaching and Applicant's background.

The Examiner further argues at the top of page 11 that Tosey states that it can determine when the hub fails "therefore, the link test must also be used to test connectivity to the hub." Applicant strongly disagrees. Tosey indicates that if a network peer fails to respond to a ping this may indicate a failure somewhere within the transmission line/connection path between the sending device and the network peer. However, there is no way in the Tosey method to know if the problem is between the sending device and the hub because the ping is not sent to the hub and responded to by the hub (i.e., the response is NOT from the hub which merely passes the ping and the response). The connectivity problem may be between the hub and the peer device or with the peer device itself. Further relevant discussion of the differences between the system of claim 1 and Tosey's teaching are provided in the September 15, 2005 Amendment from the second paragraph on page 9 to the end of page 11.

Independent claim 8 is directed to a method claim with similar limitations (but in method form) as that of claim 1. Hence, the reasons for allowing claim 1 over the combined teachings of Applicant's Background and Tosey are believed applicable to claim 8. Claims 9-13 depend from claim 8 and are believed allowable as depending from an allowable base claim.

Independent claim 15 is similar to claim 1 but calls for specific network information to be transferred to the secondary NIC, and the transfer of this type of information is not shown by the cited references. The Office Action cites Figures 5A and 5B showing transferal of a mobile IP address for a failed NIC 25 to a secondary NIC 26. However, this does not show transferring network information

including IP addresses "of other devices connected to the network netmask, or broadcasts" from a primary to a secondary NIC. Hence, the Examiner has failed to state a *prima facie* case of obviousness with regard to independent claim 15 as Tosey fails to overcome the admitted lack of teaching of the claimed invention in Applicant's Background.

Additionally, Applicant believes it was error not to enter the Amendment filed September 15, 2005 as it simply provided a revised Figure 1 and amended claim 15 to address an antecedent basis issue, which would place the claim in condition for allowance or better condition for use on appeal without raising any new issues.

When these issues are resolved, Applicant believes that all the pending claims are in condition for allowance and continuance with an Appeal is unnecessary.

### **Conclusions**

In view of all of the above, Applicant respectfully requests that a review panel review the Examiner's rejections and produce a finding that there are no actual issues remaining for appeal and that the application is allowed.

A check is provided for the fee associated with a filing of a Notice of Appeal. However, any fee deficiency associated with this submittal may be charged to Deposit Account No. 50-1123.

Respectfully submitted,



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November 18, 2005